

POST-GRANT PROCEDURES

Under the America Invents Act (AIA), *ex parte* reexamination and *inter partes* review has attracted substantial use, especially when threatened with litigation or after a complaint has been filed. With attorneys already well versed in reissue and reexamination procedures, WHDA is well equipped for the post-grant procedures under the AIA.

In particular, our Post-Grant Group has seen from its years of experience that reexaminations are often as effective as litigation in dealing with a competitor's patents, even very strong patents. Additionally, reexamination procedures are considerably less expensive than the alternative of District Court litigation. Reexaminations filed by WHDA have already resulted in quite a number of notable successes for our clients. Our Post-Grant Group has therefore committed itself to identifying successful strategies for utilizing post-grant procedures. This can include a two-pronged attack of simultaneous litigation and *ex parte* reexamination/*inter partes* review when necessary, and our Post-Grant Group understands the complexities of such a strategy.

Sample Reexaminations

95/001,652 - After our client's \$6M win in a parallel district court litigation, we successfully defended the client's asserted patents in *inter partes* reexamination without any claim amendments. This resulted from our proactive interview with the Examiner and demonstration of the invention during *ex parte* prosecution, and a well-developed "unexpected benefits" theory in both the *ex parte* prosecution and the *inter partes* reexamination to overcome 24 different grounds of rejections.

90/010,027 - The patentee had threatened our client with a patent infringement action. After a long time after filing of the reexamination, no patent infringement action was pursued against our client.

90/010,468 - Our client was sued for patent infringement. We filed this reexamination and stayed the district court lawsuit. The claims were ultimately amended in the reexamination and the infringement lawsuit was never resumed in view of those claim amendments.

90/010,894 - We filed a reexamination on a patent assigned to our client's competitor. All the claims of that patent were cancelled. No claims survived this reexamination.

90/011,893 - The patentee threatened our client with infringement of this patent. After we filed this reexamination, the claims were amended in a manner that precluded infringement. No patent infringement lawsuit was filed.

90/011,267 - The Examiner in reexamination of our client's patent rejected the claims. Our appeal to the Board of Appeals and Interferences resulted in the reversal of the rejections and affirmance of the patentability of all the claims.

90/012,049 - We successfully defended against this reexamination of our client's patent and secured confirmation of the patentability of the claims.



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